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09/428,284	10/27/1999	ANDREW D. HOLMES	3894	4449

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EXAMINER
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HARBECK, TIMOTHY M

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3628

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Please find below and/or attached an Office communication concerning this application or proceeding.



## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 22, 24-33, 35-50, 52-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over NEMZOW (US 2001/0011241).

**Re Claim 1:** NEMZOW discloses a computer-implemented system for managing financial transactions, a method for applying an exchange rate to convert a transaction from a first currency to a second currency, comprising:

receiving, by a computer system, a financial transaction, including a date and a transaction amount in the first currency (100).,

accessing, by the computer system, an electronically stored plurality of historical exchange rates for the first currency with respect to the second currency, each exchange rate corresponding to a time period (110; paragraph (0050)),

automatically applying, by the computer system, the selected historical exchange rate to the received financial transaction, to derive a converted transaction amount in the second currency (120,130); and

performing at least one of the steps of storing the converted transaction amount in a storage medium; and

outputting the converted transaction amount (150; paragraph 0049-0061);

Nemzow does not explicitly disclose the steps of:

if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates; automatically selecting, by the computer system, the historical exchange rate;

if the date of the received financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting, by the computer system, a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of

the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

**Re Claim 2:** Nemzow discloses the claimed method supra and further discloses wherein each time period comprises one selected from the group consisting of:

- A date; and
- A range of dates (Page 3, paragraph 0046)

**Re Claim 3:** Nemzow discloses the claimed method and further discloses storing the received financial transaction including the date, the transaction amount, and the selected exchange rate (Page 3, paragraphs 0043 “inputs that define the transaction;” paragraph 0044 “the user inputs are stored”).

**Re Claim 4:** Nemzow discloses the claimed method supra but does not explicitly disclose receiving input overriding the selected exchange rate, the input comprising a second exchange rate. However, Nemzow notes that conversion rules are specified from a number of sources including immediate user input (Paragraph 0050-0051). It therefore would have been obvious to anyone skilled in the ordinary art at the time of invention to use the Nemzow system to receive input overriding the selected exchange rate, since the system of Nemzow is designed to be customizable to any conversion configuration. While not disclosing every possible input or rule associated with currency exchanges, the broad language and Nemzow's explicit statement that “the user specifications are not limited to those listed here,” indicate that the open structure of the invention is meant to encompass as many scenarios as possible.

**Re Claim 5:** Nemzow discloses the claimed method and further discloses the step of storing, in the stored plurality of exchange rates, the second exchange rate and a corresponding time period for the second exchange rate (Paragraph 0050 "taking user input for conversion rules and rates.")

**Re Claim 6:** Nemzow discloses the claimed method supra and further discloses the step wherein the financial transaction is a transfer between accounts (Paragraph 0003; "translate between the currencies of a sender of a product and a receiver." This is a transfer between the respective parties accounts.)

**Re Claim 7:** Nemzow discloses the claimed method supra and further discloses the step wherein the financial transaction is selected from the group consisting of an investment purchase and an investment sale (paragraph 0025)

**Re Claim 8:** Nemzow discloses the claimed method supra and further discloses the step wherein outputting the converted transaction amount comprises generating a report including the converted transaction amount (paragraph 0064) and outputting the generated report (0054).

**Re Claim 9:** Nemzow discloses the claimed method supra and while not explicitly disclosing wherein the report is selected from the group of a capital gains report, a transaction report and an investment report, these types of reports are notoriously well known in the art and would have been obvious to anyone of ordinary skill so that they could see the output of the transaction in a variety of different formats that can help them evaluate the current transaction and plan for future ones.

**Re Claim 10:** Newzow discloses all the claimed features similar to claim 1 above, and while not explicitly disclosing the step wherein the computer system handles a plurality of transactions, the step was old and well known in the art and would have been obvious to anyone of ordinary skill. A computer system as disclosed by Nemzow with a processor and a database can accept more than one transaction for storage so that the system is not delayed every time one transaction is being processed. The system would contain a queue of pending transactions so that users could easily and efficiently enter inputs without having delay.

**Re Claims 11-14:** Further method claims would have been obvious from previously rejected claims 6-9 and are therefore rejected using the same art and rationale.

**Re Claim 15:** Nemzow discloses a method for generating a financial report including at least two transactions comprising

- Retrieving, by a computer system, a first transaction including a first date, a first transaction amount in a first currency, and a first historical exchange rate for the first currency responsive to the first date (paragraphs 0046-0047; “transaction rules including the dates and time defining the transaction or transactions”)
- Retrieving, by the computer system, a second transaction including a second date, a second transaction amount in a second currency, and a second historical exchange rate for the second currency responsive to the second date (paragraphs 0046-0047; “data having

multiple entries with various associated times and bases, in relation to a plurality of other currencies could be stored;" and "transaction rules including dates and time defining the transaction or transactions" indicates multiple currencies and multiple transactions)

While not explicitly disclosing the step of automatically applying the first historical exchange rate to the first transaction and the second historical exchange rate to the second transaction to produce the respective converted amount in a home currency, Nemzow notes that the conversion rules are specified by the user and therefore, if a user wanted to implement the above steps it could easily have been done using these rules (paragraphs 0050-0051). It is the examiners assertion that any exchange involving a currency translation could be implemented using these rules since the system stores a plurality of currency rates respective to time (0046). Further more the user describes the targeted currency rate and may also list a base (home currency) which would be the default. An output involving both transaction would also be obvious to anyone skilled in the ordinary art at the time of invention as a way to compare the first and second currencies and possible derive a relationship therefrom if such a relationship is not presently recognized by the system.

Nemzow does not explicitly disclose the steps of:

if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates; automatically selecting, by the computer system, the historical exchange rate;



if the date of the received financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting, by the computer system, a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

**Re Claim 16:** Nemzow discloses the claimed method supra and while not explicitly disclosing wherein the first currency is the same as the second currency, since the user of the system is responsible for inputting this information (paragraph 0043 and

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0047), it would be obvious to anyone skilled in the art to perform this step in the Nemzow system if they so desired.

**Re Claim 17:** Nemzow disclose the claimed method and further discloses the step wherein each of the steps of obtaining a first exchange rate and a second exchange rate comprises retrieving an exchange rate from an exchange rate history table responsive to the date of the transaction (paragraph 0046; "currency rates would be delivered by the rate data feed, or data having multiple entries with various associated times and bases, in relation to a plurality of other currencies could be stored.")

**Re Claim 18:** Further method claim would have been obvious from previously rejected claim 9 and is therefore rejected using the same art and rationale.

**Re Claim 19:** Nemzow discloses a software product for managing financial transactions comprising:

- An exchange rate table for storing a plurality of historical exchange rates for a currency, each historical exchange rate corresponding to a time period (paragraph 0046)
- A user interface comprising a display of historical exchange rate information, the information comprising a plurality of exchange rates obtained from the exchange rate table (paragraphs 0042-0044);
- An exchange rate code module for causing a computer system to perform the steps of: automatically selecting a historical exchange rate from the exchange rate table (paragraph 0043 "translates the original currency

value, according to these inputs and also stored conversion rules.”); and automatically applying the selected historical exchange rate to a transaction to obtain a converted transaction amount (paragraph 0043); and at least one of the steps of storing the converted transaction amount in a storage medium and outputting the converted transaction amount (paragraph 0043; “provides an output in a format as required by the user”)

Nemzow does not explicitly disclose the steps of:

Wherein the transaction has a date and wherein automatically selecting the historical exchange rate comprises:

- if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates; automatically selecting, by the computer system, the historical exchange rate;
- if the date of the received financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting, by the computer system, a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states “the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051).” While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his

invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses “if” statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant’s invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

**Re Claim 20:** Nemzow discloses the claimed software product supra and further discloses wherein each time period comprises one selected from the group consisting of:

- A date; and
- A range of dates (Page 3, paragraph 0046)

**Re Claim 22:** Nemzow discloses a computer-implemented system for managing financial transactions, a user interface for applying exchange rates to financial transactions, comprising:

- A first user interface element for receiving user entry of a financial transaction including a date (page 0043; accepts a plurality of inputs that define a transaction)

Nemzow does not explicitly disclose

- A second user interface element for displaying, by a computer system, a default value for an exchange rate, the default value corresponding to one selected from the group consisting of
  - A historical exchange rate having a time period corresponding to the date of the financial transaction and
  - A historical exchange rate having a time period that is most recent among available historical exchange rates having time periods prior to the date of the financial transaction

However Nemzow does allow the user a great deal of freedom in terms of setting conversion rules, including the conversion rates and rules for determining these rates (paragraph 0050). Therefore it would have been obvious to anyone skilled in the ordinary art at the time of invention to simply make these rules to the aforementioned specifications if they so choose. Furthermore it would have been obvious to anyone skilled in the ordinary art to use the most recent historical exchange rate if the exact date is not available because this is the most accurate measurement you would have. It would not make sense to use an earlier recorded rate because more time has surpassed and more variables are involved than with the most recent recording. Nemzow also discloses retrieving by the computer system, at least one of user entry of and user selection of an exchange rate for the financial transaction (paragraph 0049, immediate user input).

**Re Claim 24:** Nemzow discloses a computer-implemented system for applying multiple exchange rates comprising:

- A list of currencies (paragraph 0044)
- For each currency, a list of historical exchange rates, each exchange rate corresponding to a time period (paragraph 0046)
- A transaction register for storing transaction records, each of at least a subset of the transaction records (paragraph 0042; user inputs are transactions)
- A transaction input interface for receiving user entry of at least one transaction for storage in the transaction register, each transaction having a date (paragraph 0047; accepts inputs of data from the user...including dates and times defining the transaction)

Nemzow does not explicitly disclose an exchange rate selector for automatically selecting for at least a subset of the entered transactions, an exchange rate from the list of historical exchange rates by:

- if the date of the entered transaction corresponds to a time period of one of the historical exchange rates; automatically selecting the historical exchange rate;
- if the date of the entered financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states "the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051)." While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses "if" statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within.

Nemzow further discloses wherein the transaction input interface displays the selected exchange rate (paragraph 0043; output in the format as required); and wherein the transaction register stores the selected exchange rate in the corresponding transaction record (0045; These elements are stored in the various records in the database)

**Re Claim 25:** Nemzow discloses the claimed system and further discloses a report generator, coupled to the transaction register, for generating a report including at least one transaction report the report including the exchange rate of the transaction

record (0043, currency converter system provides an output in a format as required by the user).

**Re Claim 26:** Nemzow discloses a computer-implemented system for applying multiple exchange rates comprising:

- an exchange rate storage device for storing a plurality of historical exchange rates for converting a first currency to a second currency, each exchange rate corresponding to a time period (paragraph 0046)
- a transaction storage device for electronically storing at least one financial transaction in the first currency, including a date (paragraph 0047)

Nemzow does not explicitly disclose an exchange rate selector, coupled to the exchange rate storage device for automatically selecting for at least one stored financial transaction, an exchange rate from the plurality of historical exchange rates by:

- if the date of the entered transaction corresponds to a time period of one of the historical exchange rates; automatically selecting the historical exchange rate;
- if the date of the entered financial transaction not corresponding to a time period of one of the historical exchange rates, automatically selecting a historical exchange rate having the most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction.
- A transaction display, coupled to the transaction storage device and to the exchange rate selector for automatically applying the selected stored



exchange rate to the at least one stored financial transaction to obtain at least one value in the second currency, and for displaying the at least one value.

However, Nemzow does disclose that a user can specify conversion rules or use table rates and dynamic databases (Fig 110 and paragraph 0051). Nemzow states “the conversion rules are customized in response to the user inputs and the transaction rules (paragraph 0051).” While it is true that the Nemzow does not specifically point toward every possible user defined conversion and transaction rule that could apply to his invention, the broad language of Nemzow would allow for any user specified conversion and transaction rules. The fact that the applicant uses “if” statements in the body of the claims, points to the fact that these are conditional statements, or in other words, are associated with certain rules and parameters. A user of the Nemzow method could achieve the same result as a user of applicant’s invention simply by entering, into the computer system, the above rules. Then any transaction that falls within the parameters of the rule would have the intended action performed upon it. Any and all of the applicants arguments involving the above passage can thus be directed toward paragraph [0051], and traversed based upon the teachings within. Further more it would have been obvious to anyone skilled in the ordinary art at the time of invention to include a transaction display for displaying the at least one value so that the user can see the output of the system and the results of the currency transaction.

**Re Claim 27:** Nemzow discloses the claimed system and further discloses wherein the transaction storage device stores the financial transaction including the applied exchange rate (paragraph 0044).

**Re Claim 28:** Nemzow discloses the claimed system and further discloses a report generator, coupled to the transaction storage device, for generating a report including the financial transaction in the second currency (Paragraphs 042-043).

**Re Claim 29:** Further system claim would have been obvious in order to perform previously rejected method claim 1 and is therefore rejected using the same art and rationale.

**Re Claim 30:** Nemzow discloses the claimed system and further discloses an exchange rate table, coupled to the exchange rate retrieval device, for storing the obtained exchange rate and the date (paragraph 0046).

**Re Claim 31:** Nemzow discloses the claimed system and further discloses a report generator, coupled to the transaction storage device, for generating a report including the financial transaction (paragraph 0043 "output in a format as required by the user.")

**Re Claim 32:** Further system claim would have been obvious to perform previously rejected method claim 15 and is therefore rejected using the same art and rationale.

**Re Claim 33:** Nemzow discloses the claimed system and further discloses a transaction storage device for storing at least two financial transactions and an associated exchange rate for each financial transaction (paragraph 0044).

**Re Claim 35-50, 52-54 and 56:** Further computer program product claims would have been obvious in order to implement the previously rejected method claims 1-16, 18-20 and 22, respectively, and are therefore rejected using the same art and rationale.

***Response to Arguments***

Applicant's arguments filed 5/18/2006 have been fully considered but they are not persuasive.

The applicant has argued that Nemzow "does not seek an accurate valuation where the transaction does not correspond to a historical exchange rate; it seeks to optimize the value of the transaction when there is missing data." However the examiner believes that the applicant has mischaracterized the term optimization to mean "maximize," where in fact the literal (and contextual) meaning of the term is "to improve to the greatest possible extent," or "to use most efficiently." This can best be explained by Nemzow's statement that "the system can produce a single result or a matrix of results from which the user can choose an optimal valuation (paragraph 0032)." If the system was specifically designed to only seek the maximum valuation, there would be no necessary choice to make; there would be only one result. On the contrary, Nemzow allows a user to both input customized conversion and transaction rules; as well as select an optimal valuation. In light of these facts, the examiner contends that the correct interpretation of "optimize" is to find the best result according to the user specified rules, not necessarily the maximum. Finally the prevailing goal of the Nemzow invention is to fulfill the "need for a system to perform this task efficiently and accurately (0008) by developing a "currency translation system that provides for the

dynamic translation of a first currency value into a second currency value for the purpose of aiding localization and globalization of financial transactions (0032).” Again the examiner contends that the purpose is not necessarily to maximize a valuation, but could be seeking optimization in terms of accuracy in translation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With regards to the applicants claim that the examiner has provided no teaching in the cited reference to support the suggested modifications, it has been found that “a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). In the immediate instance the problem involves the use of a most recent historical exchange rate when one is not immediately available.

Nemzow not only provides historical exchange rate information (0004, 0053) but also provides suggestions for applying backtracking techniques to solve for missing links (0059). Therefore it is the examiners contention that a person of ordinary skill in the art would have been motivated, in view of the nature of the problem, to modify the system of Nemzow to seek a most recent historical value as possibly the most rudimentary backtracking technique (as opposed to triangulation or other complex data processing techniques).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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